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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,014	02/28/2002	Andrea Hughs-Baird	0112300-610	3796
29159	7590	04/04/2006	EXAMINER	
BELL, BOYD & LLOYD LLC			MOSSER, ROBERT E	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			3712	
DATE MAILED: 04/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,014

Applicant(s)

HUGHS-BAIRD ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-17, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-10, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**



**This action is Non-Final.**

**Claims 1-18 and 20-22 are pending.**



***Terminal Disclaimer***

The terminal Disclaimer filed in this application on October 12<sup>th</sup>, 2005 was approved hence the previous presented rejections under double patenting and USC 103 have been withdrawn.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28<sup>th</sup>, 2006 has been entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-10 18**, and **20** are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,648,754)

[The content of section below entitled, Response to Arguments is incorporated herein]

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding at least claim **1**, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values (equivalently offers) greater than zero and payable to the player (See grid Figure 4b & Elm 112, 120 );

A plurality of player selectable masked selections (Elements 108a-108x);

A display device (Figure 1, Elements 30, 32); and

A processor adapted to communicate with the display device (Figure 2), said processor and said display device adapted to:

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- (a) associate said values with said selections (Col 6:47-51);
- (b) enable a player to select one of said selections (Col 6:47-51);
- (c) reveal the value associated with the selected selection to the player (Col 6:47-51);
- (d) enable the player to accept or reject the revealed value (Col 6:52-63); and
- (e) repeat steps (a) through (d) at least once if said player rejects said revealed value, wherein if the player rejects said revealed values, said revealed value is re-associated with one of said masked selections for at least one subsequent selection (Col 10:30-44).

Regarding claims **2-3**, the plurality of values are randomly selected and associated with game selections (Col 7:40-61) from a pool of offers wherein the "pool" of offers includes all tangible game offers.

Regarding claims **4, 7** and **9**, Baerlocher shows in the grid of figure 4b a number of offers equal to the number of selections. Wherein a step number is associated with each possible selection shown and the instant language "number of offers" is met by the multiple presentation of a single value (Figure 23, Element 108. "23"). Additional claim language in claim 9 stating, "each said offer" is not equivalent to "each unique offer" and hence fails to separate from the prior art of Baerlocher.

Regarding claim **5**, Baerlocher may be considered alternatively to teach the inclusion of a number of values greater than the number of selections in the realization of "the present invention includes not associating or placing one or more possible steps" (Col 7:45-50).

Regarding claims **6** and **10**, Baerlocher may be considered alternatively to teach the inclusion of a number of values less than the number of selections. Wherein a step number is associated with each possible selection shown in figure 4b contains the use of repeated specific values such as the number 23 (Col 7:40-60). Hence as understood this can be interpreted as a number of unique values less than the number of selections.

Regarding claim **8**, Baerlocher teaches the re-association (reshuffling) of values with selection after the user rejects one selection (Col 10:29-44).

Regarding claim **18**, Baerlocher et al teaches a method for operating a gaming device including the triggering a gaming device (Col 4:15-29), associating a plurality of non-zero values payable to the player with a plurality of selections (Col 7:40-46), displaying said plurality of selections (Figure 4), revealing the value associated with one of the selections picked by the player (Figure 5b), allowing the player to accept or reject the value, providing the value to the player if the player accepts the value or the selection is the last selection, and when the player selection is not their last selection/pick repeating the above if the player rejects the value including re-associating the rejected value into one of the possible selections for a subsequent selection (Col 10:36-44). Baerlocher further allows for the "reshuffling" of the steps and their associated order (Col 10:36-44), which in turn is understood as the claimed rearrangement of the selections wherein each selection remains associated with said previously associated value.

Regarding claim **20**, the apparatus/method of Baerlocher teaches revealing a singular value associated with each selection and hence this singular value must represent the maximum and minimum offer (Figure 4).

### ***Response to Arguments***

Applicant's arguments filed February 28<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

The office action of November 23<sup>rd</sup> 2005 set forth the following in the response to arguments.

In the interpretation of the newly amended claims it is noted that the applicant has replaced the word "value" with the word "offer" in some claims while retaining the use of the word "value" in other claims. As these terms have been presented interchangeable without any setting forth definition or support for a separate interpretation of these two terms they have been deemed equivalent for the purposes of this action.

The applicant's remarks presented February 28<sup>th</sup>, 2006 challenge this equation based on several assertions

Each "offer" in Claims 1 to 10, 18 and 20 may be accepted or rejected by a player if the player selects the selection directly associated with that offer. On the other hand, each "value" in Claims 11 to 17 and 21 will be provided to a player if the player selects the selection associated with that value.

The applicant's assertions are primarily based on the use of these respective terms in a given set of claims and not the terms themselves for while their particular use

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is separated by an associated acceptance/rejection feature or the lack thereof in the claims the term -value- and -offer- does not in of itself imbue specific functional definition. Therefore while the claim limitations associated with the specific aspects of an acceptance/rejection feature are noted in a subset of the claims, the claims as presented could present a -value- for acceptance/rejection equally to presenting an -offer- for acceptance/rejection. In kind an -offer- may include an acceptance/rejection aspect as the term -value- may also include an acceptance/rejection feature. Hence though the terms may have a degree of distinction this distinction for the purposes of examination is limited to the explicit incorporation of claim features directed to the acceptance/rejection feature associated with the respective term's -offer- accompanying language and limitations, not the respective term considered in isolation. These features directed to the incorporation of an acceptance/rejection feature have been addressed in the rejections of record accordingly.

During informal telephone conversations with Applicant's representatives centered the weeks of March 5<sup>th</sup> and March 12<sup>th</sup> the Applicant's representative presented a proposed amendments to the independent claims in the interest of furthering prosecution and overcoming the prior art of record and with the understand that such amendments would only become entered if their entry would result in allowance. Though such amendments were not sufficient to overcome the pending rejections the Examiner agreed to address an exemplary claim with a piece wise correlation to the prior art of record to shed a greater light on the issues that would

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remain even in the event that such a claim were to be entered by the applicant. The claim chosen for this correlation is the proposed amended claim 1 submitted on March 10<sup>th</sup>, 2006 and attached hereto. Remaining remarks presented in the applicant's response dated February 28<sup>th</sup>, 2006 are considered addressed in the following correlation.

**Detailed claim redress:**

Claim 1 (Proposed)      A gaming device comprising:

A game including: (i) a plurality of offers, wherein said plurality of offers are payable to a player; and

(ii) a plurality of player masked selections;

a display device; and

a processor adapted to communicate with the display device, said processor and said display device

adapted, for each play of the game, to:

(a) directly and individually associate said offers with said selection, such that each offer is individually associated with a separate one of the selections,

(b) enable the player to select one of said selections,

(c) reveal the offer individually associated with the selected selection to the player,

(d) enable the player to accept or reject the revealed offer,

(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, said revealed offer is individually reassociated with one of said masked selections for at least one subsequent selection by the player; and

(f) if the player accepts said revealed offer, pay said revealed offer to the player.

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[First correlation – The claimed “Offers” are associated with the column of offers Shown in USP 6648754, Figure 5 and Element 102 in the same figure as demonstrative thereof]

Claim 1 (Proposed) A game including: (i) a plurality of offers (-Monetary amounts shown in Fig 5 Right hand side-), wherein said plurality of offers are payable to a player (-a credit prize receivable by the player ranging from 20 – 500 credits-); and

(ii) a plurality of player masked selections (The matrix elements 108 shown masked in Figure 5);  
a display device (Element 30); and

a processor adapted to communicate with the display device, said processor and said display device adapted, for each play of the game (System configuration shown in Figure 2), to:

(a) directly and individually associate said offers with said selection, such that each offer is individually associated with a separate one of the selections, <See **\*\*1\*\*** below>

(b) enable the player to select one of said selections (Figure 5B Elm 120),

(c) reveal the offer individually associated with the selected selection to the player <See **\*\*2\*\*** below>,

(d) enable the player to accept or reject the revealed offer (Elm 106, & Col 6:51-55),

(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, said revealed offer is individually reassocated with one of said masked selections for at least one subsequent selection by the player(Col 10 36-44); and

(f) if the player accepts said revealed offer, pay said revealed offer to the player (Elm 106, 116).

**\*\*1\*\*** - In this case each offer (prize offer) is directly and individually associated with the selections such that each offer (Ex “30”) is “individually” associated with multiple ones of the selections of the values associated with the selectable elements 108 shown unmasked in figure 4b of the prior art. The language “directly” and “individually” set

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forth limitations presently which do not exclude multiple direct and individual associations with a each distinct or as presented "separate" one of said selections.

\*\*2\*\* - This passage follows the logic of \*\*1\*\* as presented wherein the revealing is provided through the tabular correspondence shown in at least the right hand portion of figures 4 and 5, as well as being demonstrated in Element 102.

Example of claimed correlation:

Upon game initiation the player is presented with a plurality of offers, a plurality of masked selectable selections (or step values), as the player selections one of the selections shown in figure 5, the offer associated with the number of accrued steps is presented to the player (Elm 102). The player is permitted to accept/reject the offer and dependent thereon the selections may be rearranged for a subsequent selection (Col 10:30-44). This "association" between the masked selections and the offer would be defined by the mapping of the resultant number of accrued steps for any given selection during the game to their corresponding credit values shown in Column 10, lines 13-14 and Figure 5. Each offer is further individually associated with multiple separate selections in so much as each selection during a given point of the game corresponds to a particular offer through the association described above. The offers are obtainable by the player through their selection and wherein upon the obtainment of the offer by the player the player may elect to accept or reject the offer obtained for an associated amount of credits.

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Hence if a player were to select the selection associated with 2 steps (elm 108n) the initial offer would be 20 credits (figure 5). On a subsequent selection the player may select a selection again associated with 2 steps yielding a total of 4 accrued steps and as can be seen in figure 5, the offer associated with the player's selection would again be 20 credits thereby allowing a first and subsequent selection of an offer by the player.

The examiner has attempted to provide an example as requested by applicant during the informal interviews cited above. It is desirable that such example will serve to further prosecution by reducing the issues between the pending claim language and prior art to provide a common basis for understanding for all parties.

#### ***Allowable Subject Matter***

Claims 11-17 and 21-22 are allowed.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

  
**XUAN M. THAI**  
**SUPERVISORY PATENT EXAMINER**  
TC3700